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OFFICE OF PETITIONS

In re Application of
Furaya et al.
Application No. 10/042,229
Filed: January 11, 2002
Attorney Docket No. 084437-0158

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: **DECISION DISMISSING PTA REQUEST**
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This decision is in response to Applicants' "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)" timely¹ filed on December 10, 2004 requesting that the Patent Office adjust PTA to 70 days.

Applicants request for reconsideration of PTA is **DISMISSED as to the request for 35 days relating to fail to mail at least one notification within fourteen months as required under 37 CFR 1.702(a)(1).**

The instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Patentees are given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Patentee may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Petitioner is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the application which

¹ Issue fee paid on December 10, 2004

overlap with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

Applicants assert that two Office delays occurred during patent prosecution. First, applicants assert that the Office failed to mail at least one notification within fourteen months of the filing date of the application. Applicants assert that the filing date of the application was December 28, 2001 and the date of the mailing of the first notification (an election/restriction) was March 25, 2003. In addition, applications project that the issue date will be more than three years beyond the filing date of the application. Applicants agree with the two reductions of 33 days and 2 days pursuant to 37 CFR 1.704(b).

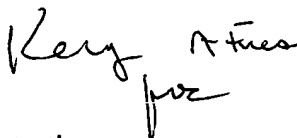
As noted supra, the Office will hold in abeyance any determination of whether the three year requirement has been met until the actual issue date is known. As to the 35 days relating to the violation of 37 CFR 1.702(a)(2), the Office asserts that the 14 month requirement was met. The application was filed on January 11, 2002² and the first notification occurred on January 29, 2003, a restriction requirement.³ Accordingly, the Office met the 14 month requirement.

The Office acknowledges authorization to charge a fee of the \$200.00 fee set forth in 37 CFR 1.18(e) to Deposit Account 23-1925 . No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent. Any delays in issuing the application more than four months after payment of the issue fee and other requirements being satisfied will be reflect in the issue notification letter mailed approximately 3 weeks prior to issuance.

Telephone inquiries specific to this matter should be directed to Kery Fries at 571-272-7757.

Kery Fries
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy



²The Office is not sure how applicants assert filing date is December 28, 2001. The Office believe the date to be January 11, 2002.

³The Office is also unsure as to applicants assertion that the restriction occurred on March 25, 2003. The image file wrapper reflects the date of January 29, 2003.